

REMARKS

Status of Claims

Applicant has cancelled claims 2 and 3, and has amended claim 1 to include the features of claim 3, to further emphasize patentable and nonobvious features of the claimed refrigerating machine oil composition. Applicant also has amended claims 4-9 to clarify the claim language. Applicant also has added new claims 10-16 to round out the coverage to which it is entitled. Amended claims and new claims are supported at least by the original claims, and are not new matter.

Double Patenting Rejection

The Examiner provisionally rejected claims 1-3 and 5-9 on the grounds of nonstatutory obviousness-type double patenting over claim 10-18 of copending Application No. 10/566,494. Since no claims are allowable in either of the relevant applications, Applicant respectfully requests that the double patenting rejection be held in abeyance until allowable subject matter is indicated either in the present application or in Application No. 10/566,494. See M.P.E.P § 804(I)(B).

Rejections under 35 U.S.C. §§ 102(b) and 102(e)

Applicant respectfully traverses the rejection of claims 1, 4-7 and 9 under 35 U.S.C. § 102(b) over U.S. Patent No. 5,403,503 to Seiki et al. ("Seiki"), and the rejection of claims 1, 4-7 and 9 under 35 U.S.C. § 102(e) over U.S. Patent No. 6,667,285 to Kawahara et al. ("Kawahara"),

Amended claim 1 recites a refrigerating machine oil composition comprising a prescribed base oil, a phosphorothionate, a phosphorus-based extreme pressure agent other than said phosphorothionate, and an oil agent. As the Examiner admitted in pages 2-5 of Office Action, neither Seiki nor Kawahara, alone or in combination, discloses or suggests the above features of amended claim 1. Since anticipation under § 102 requires that all of the claim elements be disclosed in a single reference, amended claim 1 therefore is not anticipated by either Seiki or Kawahara.

Rejections under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claim 8 under 35 U.S.C. § 103(a) over Kawahara. Claim 8 depends from amended claim 1, and incorporates all of the features recited in amended claim 1. As discussed above, Kawahara neither discloses nor suggests all of the features of amended claim 1. Claim 8 therefore is not obvious over Kawahara at least due to its dependence from amended claim 1. See M.P.E.P. § 2143.

The Applicant also respectfully traverses the rejection of claims 2 and 3 under § 103(a) over Kawahara in view of U.S. Patent No. 6,228,282 to Shimomura et al. ("Shimomura").

To establish a *prima facie* case of obviousness, three basic criteria must be met. M.P.E.P. § 2143, 8th Ed., Rev 7 (July 2008). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. M.P.E.P. § 2143; see also *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir.

1998). Although the Supreme Court cautioned against an overly rigid application of “teaching, suggestion, or motivation” (TSM) approach, it also recognized that use of a teaching/suggestion/motivation approach to the question of obviousness “captured a helpful insight.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739 (2007); *Id.* at 1741 (citing *In re Bergel*, 292 F.2d 955, 956-57(1961)). Further, in its published examination guidelines, the USPTO concurred that the TSM approach is a valid rationale for determining obviousness. See M.P.E.P. § 2141(III). Second, there must be a reasonable expectation of success. M.P.E.P. § 2143. Third, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. M.P.E.P. § 2143. Further, “[t]he key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.” M.P.E.P. § 2142.

As discussed regarding the § 102(e) rejection over Kawahara, the Examiner admitted in pages 2-5 of Office Action, that Kawahara fails to disclose or suggest the features of cancelled claim 3, now recited in amended claim 1.

The Examiner asserted that Shimomura discloses “additives . . . such as phosphoric esters (phosphorous compound) and sulfur compounds . . . such as phosphorothionates” Office Action, p. 5. Shimomura discloses at col. 7, lines 16-23 that a specific phosphorus compound can be used, and discloses at col. 8, lines 18-31 that a sulfur -containing additive can be incorporated into the refrigerating machine oil. Shimomura, however, does not expressly disclose or suggest the combination of a phosphorothionate and a phosphorous-based extreme pressure agent other than the phosphorothionate, as recited in amended claim 1.

Moreover, as disclosed in the as-filed specification, e.g., Tables 83-94, the compositions recited in amended claim 1 have superior unexpected beneficial results, i.e., less abrasion volume and abrasion loss, in comparison with examples, as shown in Tables 1-82, which do not have a phosphorothionate in combination with a phosphorus-based extreme pressure agent other than the phosphorothionate. For example, Example No. 464 containing the combination of a phosphorothionate (A4) and a phosphorous-based extreme pressure agent other than the phosphorothionate (A1) shows less abrasion volume and abrasion loss, in comparison with Example Nos. 1 and 401 which only use a phosphorus-based extreme pressure agent other than the phosphorothionate (A1) without a phosphorothionate. A similar result can be observed by comparing Example No. 480 and Example Nos. 51 and 413, as shown in the table below, which is generated from Tables 1, 9, 68, 70, 84, and 85.

	A1+A4	A1 only	A1 only	A1+A4	A1 only	A1 only
Example No.	464	1	401	480	51	413
Abrasion Volume 1 (mm ³)	1.7	2.0	n/a	2.5	3.0	n/a
Abrasion Loss 3 (mg)	7.0	n/a	7.6	7.6	n/a	8.3

One of ordinary skill in the art would not reasonably have expected the successful results exhibited by the claimed composition using the combination of a phosphorothionate and a phosphorous-based extreme pressure agent other than the phosphorothionate. See M.P.E.P. § 2143.02.

For the foregoing reasons, Applicant respectfully submits that Kawahara in view of Shimomura would not have rendered the claimed oil composition obvious, and thus no *prima facie* case of obviousness has been established.

Claims 2-9 depend from claim 1 and incorporate all of the features recited in amended claim 1. Claims 2-9 therefore are not obvious over the cited references at least due to their dependence from amended claim 1.

Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration of the claims, and a timely notice of allowance.

If there is any fee due in connection with the filing of this Statement, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

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